

### **REMARKS**

This amendment is in response to the Office Action mailed August 25, 2006. Claims 1 and 6 have been amended, claims 10, 11 and 20 have been cancelled and claims 36-38 have been added. Claims 1, 3, 4, 6, 8, 9, 12-17, 19, 21, and 27-38 are presently pending. No new matter has been added.

The Applicants gratefully acknowledge the indication in the Office Action that Claim 35 contains allowable subject matter and would be allowed if rewritten in independent form including all the limitations of the base claim and any intervening claims.

### **§103 Rejections**

Claims 1, 3, 4, and 6 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,469,634 to Williams et al. ("Williams") in view of U.S. Patent No. 5,305,464 to Frett ("Frett"). Claims 14, 19, 21, 27-32, and 34 were rejected under 35 U.S.C. §103(a) as being unpatentable over Williams in view of U.S. Patent No. 5,303,063 to Kim et al. ("Kim"). Claims 8, 10, and 12 were rejected under 35 U.S.C. §103(a) as being unpatentable over Williams in view of Frett and further in view of Kim. Claims 15, 16, and 33 were rejected under 35 U.S.C. §103(a) as being unpatentable over Williams in view of Kim and further in view of Frett. Claims 9, 13, and 17 were rejected under 35 U.S.C. §103(a) as being unpatentable over Williams in view of Frett and Kim and further in view of U.S. Patent No. 6,097,302 to Zinzell ("Zinzell"). Claims 11 and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Williams in view of Frett and Kim and further in view of U.S. Patent No. 6,580,457 to Armstrong et al. ("Armstrong"). The Applicants traverse these rejections.

Claims 1 and 6 recite detecting/determining the channel state of a set top box and, based on the channel state, sending a command from a companion box to the set top box to change the channel of the set top box to a user-specified, pre-programmed channel. Neither Williams nor Frett teach or suggest this claim element. Williams discloses a universal remote control that determines the correct command codes for functions of a particular device, such as a television, by selecting a command code for a function of that device, transmitting the command code, and detecting whether

the device performed the function. (See, Williams, Fig. 3 and accompanying text.) If not, then the remote control tries again using a different command code. (*Id.*) Williams does not teach or suggest that channels selected by the remote control during this process are user-specified or that the channels are pre-programmed. The remote control of Williams appears to perform this procedure without any user interaction (other than starting the procedure) or any selection of channels by the user.

None of the other cited references, including Frett, address this deficiency of Williams. Therefore, the cite references fail to teach or suggest every element of the claims. For at least these reasons, claims 1 and 6, as well as claims 3, 4, 36, and 37 which depend therefrom, are patentable over the cited references. The Applicants respectfully request withdrawal of the rejections of these claims.

Claim 8 recites a system that can determine if a channel state of a set top box matches a desired channel state and can command the IR blaster, without changing a code set, to send a change channel command via an IR beam to the set top box if the channel state does not match the desired channel state. Claim 14 recites determining the channel state of a set top box and, if the determined channel state does not match the desired channel state, sending a change channel command to the set top box to cause the set top box to change to the desired channel state, without changing codes used to configure the change channel command. Claims 27 and 28 recite a companion box that can, if a channel state of the set top box does not match the desired channel state, cause an IR blaster to send the command to change the channel state to the desired channel state, without changing the set of codes used to send the command. Claim 29 recites a method in which, based on the channel state, a command is sent via an IR blaster to change the channel state to a desired channel state, without changing the set of codes used to send the command. None of the cited references teach these elements.

Each of these claims is rejected over the combination of Williams and Kim. The Office Action acknowledges that "Williams fails to disclose sending the command without changing the set of codes used to the [sic] send the command." (Office Action, p. 5.) The Office Action asserts

that “Kim discloses automatically transmitting a command to set a desired channel state of a set top box without changing the set of codes...” (*Id.*) The Office Action then asserts that “it would have been obvious ... to modify Williams to include sending a channel change command without changing the code set.”

M.P.E.P. §2143.02 clearly states: “The proposed modification can not render the prior art unsatisfactory for its intended purpose” and “The proposed modification cannot change the principle of operation of a reference.” The proposed modification of Williams described in the Office Action would change the principle of operation of the universal remote control of Williams, rendering the remote control unable to perform its function of determining the correct command codes for functions of the device.

As indicated above, Williams discloses a universal remote control that determines the correct command codes for functions of a particular device, such as a television, by selecting a command code for a function of that device, transmitting the command code, and detecting whether the device performed the function. (See, Williams, Fig. 3 and accompanying text.) If not, then the remote control tries again using a different command code. (*Id.*)

If the remote control of Williams is modified, as suggested in the Office Action, to send “a channel change command without changing the code set,” then the remote control of Williams will no longer perform its function; namely, determining which command code performs a particular function. The remote control necessarily changes the command code each time it sends out a command to perform a function. It would be unproductive to send out the same command code when it is already determined that the device does not respond to that command code.

Furthermore, there is no motivation to combine Williams and Kim. These references are directed to achieving different objectives. Williams is directed to a universal remote control and a method of selecting command codes so that the remote control can operate a device. Kim is directed to a VCR that sends a signal to a set top box to change the channel of the set top box prior to recording a desired television program. One of ordinary skill in the art would not look to Kim to

modify Williams because Kim teaches nothing about setting up a remote control or shifting through command codes to find a code that activates a particular function on another device. One of ordinary skill in the art would not look to Williams to modify Kim because Kim is not directed to finding a correct command code to perform functions on a device. In making the rejection over the combination of Williams and Kim, the Office Action picks out portions of each reference, but ignores the context of that reference. As indicated in M.P.E.P. §2141.02, “[a] prior art must be considered in its entirety, i.e., as a whole ....” (Emphasis in original.)

None of the other references address these deficiencies of Williams and Kim. Therefore, the cited references do not teach or suggest every element of the claims. For at least these reasons, claims 8, 14, and 27-29, as well as claims 9, 10, 12-17, 19, 21, 35, and 38 which depend therefrom, are patentable over the cited references. The Applicants respectfully request withdrawal of the rejections of these claims.

Claim 30 recites determining an initial channel state and then repeatedly detecting the channel state of a set top box, comparing the current channel state to the initial channel state, and sending a command to the set top box to change to the initial channel state if the current channel state is determined to be different than the initial channel state. In other words, after detecting the initial channel state the steps of the claimed method maintain the set top box in that initial channel state. Williams and Kim do not teach or suggest these claim elements. Kim does not teach or suggest determining an initial channel state. Williams, to the extent that Williams is directed to testing channel change functions, is explicitly directed to changing the channel state from the initial channel state, not maintaining the channel in the initial channel state. Moreover, neither Williams nor Kim teach or suggest repeatedly detecting a channel state of a set top box in order to maintain the channel state in the initial channel state. Kim does not teach or suggest detecting a channel state at all.

None of the other references address these deficiencies of Williams and Kim. Therefore, the cited references do not teach or suggest every element of the claims. For at least these reasons,

claim 30, as well as claims 31-34 which depend therefrom, are patentable over the cited references. The Applicants respectfully request withdrawal of the rejections of these claims.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue. If the Examiner has any questions or concerns, the Applicants encourage the Examiner to contact the Applicants' representative, Bruce Black, by telephone to discuss the matter.

Dated: November 27, 2006

Respectfully submitted,

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